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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,865	01/27/2000	EIJI HAYASHI	35.C14206	9148

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 11/05/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/491,865

Applicant(s)

HAYASHI, EIJI

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

1. Claims 22-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6574002 to Paczewitz, Paczewitz's admission of prior art (hereafter Paczewitz), and to U.S. Patent No. 6441924 to Matsui.

3. Regarding claims 1, 8, and 15, Paczewitz discloses an information processing apparatus (computer, col. 3, line 46) for forming print data which can be interpreted by a printing apparatus (printer, Fig. 1) in accordance with document data formed by an application, comprising:

(1) setting means for setting either the mail box mode to accumulate the print data into a file (Print to file, Fig. 2, Paczewitz's admission of Prior Art) without printing it or a printer output mode (Fig. 2) to sequentially print the print data received by said printing apparatus; and

(2) forming means for forming said print data by adding information (Properties, Fig. 2) indicative of a destination (Print to file, Fig. 2) in said printing apparatus in accordance with the output mode set by said setting means.

However, the combinations of Paczewitz and Paczewitz's admission of prior art do not disclose expressly an information processing apparatus for forming print data comprising: (1) setting means for setting a mail box mode to accumulate the print data into said "printing apparatus" without printing it.

Matsui, in the same field of endeavor for information processing apparatus for forming print data, discloses a setting means for setting a mail box mode to accumulate the print data into said printing apparatus (mail box within the facsimile apparatus, col. 2, lines 2-8 and lines 53-65 and Figs. 7 & 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to modify Paczewitz's information processing apparatus for forming print data by the teachings of Matsui because of the following reasons: (1) to provide a method of automatically distributing received documents such that the received documents are quickly delivered to the right persons (Matsui, col. 1, lines 52-57); (2) it is known in the art that storing print data in the memory of the printing apparatus, thereby, allowing users to print data at later time to reduce communication congestion of print buffer.

4. Regarding claims 2, 9, and 16, Matsui further discloses an information processing apparatus for forming print data, further comprising: display control means (LCD panel, col. col. 5, lines 19-25) for, in the case where a mail-box-function of said printing apparatus cannot be used, displaying so as to make it possible to identify that a user interface (Fig. 8) to set the mail box mode by said setting means cannot be used.

5. Regarding claims 3, 10, and 17, Matsui further discloses an information processing apparatus for forming print data, further comprising: obtaining means for obtaining device information from said printing apparatus (a method of obtaining the device information indicative of the mailbox function, col. 3, lines 55-63,, and wherein display control means display and controls whether the user interface to set the mail box mode can be used or not on the basis of said obtained device information (a display control means for displaying whether a mailbox function can be used or not via a LCD display panel, col. 5, lines 19-33).

6. Regarding claims 4, 11, and 18, Matsui further discloses an information processing apparatus

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for forming print data, further comprising box designating means (input device, col. 5, lines 22-23 and col. 6, lines 5-13) for designating to which one of a plurality of mail box areas (Fig. 8 & 9) in said printing apparatus said print data is outputted when a mail box output is performed, and wherein said box designating means displays a mail box list including a box number and a box name (Fig. 8 & 9) and designates on the basis of the device information obtained by said obtaining means.

7. Regarding claims 5, 12, and 19, Matsui further discloses an information processing apparatus for forming print data, further comprising manual setting means for setting whether a mail box can be used or not on the user interface (user interface, Fig. 8) of a printer driver, and wherein said display control means (Fig. 8) displays and controls whether the user interface to set the mail box mode can be used or not on the basis of the setting by said manual setting means about whether the mail box can be used or not (col. 3, lines 26-49).

8. Regarding claims 6, 13, and 20, Paczewitz further discloses an information processing apparatus for forming print data, wherein when the output mode is switched by said setting means, said display control means displays a message indicating that there is a change of the destination (Fig. 4). It would have been obvious to change a message of Fig. 4 by Paczewitz to display a message indicating that there is a change of the destination.

9. Regarding claims 7, 14, and 21, Matsui further discloses an information processing apparatus for forming print data, further comprising name designating means (Fig. 8 & 9, col. 5,

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lines 19-32) for designating a name of the print data to be transmitted to said printing apparatus when the mail box mode is selected by said setting means, and wherein said name is a name to be displayed on an operation panel of said printing apparatus.

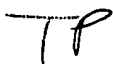
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Thierry L. Pham



Oct. 21, 2003



DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600